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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SPIGEN KOREA CO., LTD, a Republic
of Korea corporation,

CASE NO.: 8:15-CV-01050 DOC (DFMx)

Plaintiff

**DEFENDANTS ISPEAK[ER] AND
VERUS' MEMORANDUM OF
CONTENTIONS OF FACTS AND LAW**

v.

ISPEAK CO., LTD., a Republic of Korea corporation; VERUS U.S.A., LLC, a California limited liability company ; and DOES 1 through 10, inclusive.

The Honorable David Q. Carter

Defendants

Dept: 9D

Location: 411 W. Fourth St.
Santa Ana, CA 92701

VERUS U.S.A., LLC, a California limited liability company.

Trial Date: September 6, 2016 at 08:30 a.m.

Counter-Plaintiff

V.

SPIGEN KOREA CO., LTD, a Republic
of Korea corporation

Counter-Defendant

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1 **I. INTRODUCTION**

2 In this case, the sole cause of action of Plaintiff Spigen Korea Co., LTD
3 ("Plaintiff" or "Spigen") is that U.S. Patent No. 9,049,283 ("Spigen 283") is
4 infringed by Defendants Verus U.S.A., LLC ("Verus") and ISpeak[er] Co., LTD.
5 ("ISpeak") (Verus and ISpeak are collectively referred to herein as "Defendants").

6 Defendants' defenses and/or counter claims in this case relate to:

7 (i) non-infringement of Spigen 283 in view of 35 U.S.C. 271 (Plaintiff bears the
8 burden of proof by a preponderance of the evidence);

9 (ii) invalidity of all claims of Spigen 283 in view of the obviousness of the
10 claimed invention under 35 U.S.C. 103 (Defendants bear the burden of proof by
11 clear and convincing evidence);

12 (iii) unenforceability of Spigen 283 in view of Plaintiff's inequitable
13 conduct during the prosecution of Spigen 283 in withholding prior art from the U.S.
14 Patent and Trademark Office (Defendants bear the burden of proof by clear and
15 convincing evidence overall, and by a preponderance of the evidence on the issue of
16 whether the U.S. Patent and Trademark Office would have issued the patent "but
17 for" the Plaintiff's failure to disclose); and

18 (iv) limitations on damages for Plaintiff's failure to appropriately mark its
19 products with the Spigen 283 patent number, or to otherwise give notice of its patent
20 rights to Defendants, under 35 U.S.C. 287(a) (Plaintiff bears the burden of proof by
21 a preponderance of the evidence as to when it first gave Defendants notice of patent
22 infringement).

23 **II. DEFENSES AND COUNTERCLAIMS**

24 **A. NON-INFRINGEMENT**

25 Defendants have both an affirmative defense (Second Affirmative Defense) and a
26 counter-claim (First Counterclaim) for non-infringement of Spigen 283.

27 To establish infringement, Plaintiff must prove by a preponderance of evidence
28 that Defendants' accused products infringe Spigen 283 either literally or under the

1 doctrine of equivalents. *Advanced Cardiovascular Systems, Inc. v. Scimed Life*
 2 *Systems, Inc.*, 262 F.3d 1329, 1336 (Fed. Cir. 2001). Establishing literal
 3 infringement requires that every word of at least one valid/enforceable claim of
 4 Spigen 283 is met by Defendants' accused devices. *Microsoft Corp. v. Geo Tag,*
 5 *Inc., _ F.3d _,* 2016 WL 1274394 at *6 (Fed. Cir. 2016); *Revolution Eyewear, MC v.*
 6 *Aspex Eyewear, Inc.,* 563 F.3d. 1358, 1369 (Fed. Cir. 2009); *Terlep v. Brinkman*
 7 *Corp.,* 418 F.3d 1379, 1381 (Fed. Cir. 2005).

8 If there is no literal infringement, establishing doctrine of equivalents
 9 infringement requires that any difference[s] between the accused devices and the
 10 patent claim are "insubstantial," meaning that each different element provides
 11 substantially the same function in substantially the same way to achieve
 12 substantially the same result. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*,
 13 339 U.S. 605, 608 (1950); *Ring & Pinion Service Inc. v. ARB Corp.*, 743 F.3d 831,
 14 835 (Fed. Cir. 2014). If any of the function, way or result are not substantially the
 15 same, there is no infringement and so Defendants prevail in this action. See *AKZO*
 16 *Nobel Coatings, Inc. v. DOW Chemical Co.*, 811 F.3d 1334, 1342 (Fed. Cir. 2016).

17 The foregoing principles of patent infringement can also be found in "AIPLA's
 18 [American Intellectual Property Association's] Model Patent Jury Instructions"
 19 ("AIPLA Jury Instructions") found on the internet under the foregoing title, at page
 20 10 *et seq.*

21 **B. INVALIDITY-OBVIOUSNESS**

22 Defendants have both an affirmative defense (Third Affirmative Defense) and a
 23 counterclaim (Second Counterclaim) for invalidity due to obviousness under 35
 24 U.S.C. 103.

25 A claimed invention is "obvious" and thus invalid if it would have been obvious
 26 to a person of ordinary skill in the art of the claimed invention at the time the
 27 invention was made. 35 U.S.C. 103; AIPLA Jury Instructions, at 41.

28

1 The following factors must be evaluated to determine whether obviousness of the
2 claimed invention under 35 U.S.C. 103 has been established:

- 3 1. the scope and content of the prior art relied upon by Defendants;
4 2. the difference or differences, if any, between (i) each claim of Spigen
5 283 that Defendants contend is obvious and (ii) the prior art;
6 3. the level of ordinary skill in the art at the time the invention claimed in
7 Spigen 283 was made; and
8 4. additional “secondary” considerations, if any, that indicate that the
9 invention was obvious or not obvious. *See AIPLA Jury Instructions*, at 41-46.
10 “Secondary considerations” for determining either obviousness or non-
11 obviousness include the following issues:

- 12 1. Were products covered by the claim commercially successful due to the
13 merits of the invention in Spigen 283 as claimed in Spigen claims 1 through
14 22 (“claimed invention”), rather than due to advertising, promotion,
15 salesmanship, or features of the product other than those found in a claim of
16 Spigen 283?
17 2. Was there long felt need for a solution to the problem facing the
18 inventors, which was satisfied by the claimed invention?
19 3. Did others try, but fail, to solve the problem solved by the claimed
20 invention?
21 4. Did others copy the claimed invention?
22 5. Did the claimed invention achieve unexpectedly superior results over
23 the closest prior art?
24 6. Did others in the field, or Defendants, praise the claimed invention or
25 express surprise at the making of the claimed invention?
26 7. Did others accept licenses under Spigen 283 because of the merits of
27 the claimed invention?

28

1 Answering all, or some, of these questions “yes” may suggest that the claim was
2 not obvious. Answering all, or some, of these questions “no” may suggest that the
3 claims would have been obvious.

4 These factors are relevant only if there is a connection, or nexus, between the
5 factor and the invention covered by the patent claims. AIPLA Jury Instructions, at
6 45-46.

7 Obviousness must be proven by Defendants by clear and convincing evidence.
8 AIPLA Jury Instructions, at 42.

9 **C. UNENFORCEABILITY-INEQUITABLE CONDUCT**

10 Defendants have both an affirmative defense (Eighth Affirmative Defense) and a
11 counterclaim (Third Counterclaim) concerning inequitable conduct in obtaining the
12 patent in suit, Spigen 283.

13 Whether the owner of Spigen 283 engaged in inequitable conduct is an issue for
14 the Court to decide. *Flex-Rest, LLC v. Steelcase, Inc.*, 455 F.3d 1351, 1357 (Fed.
15 Cir. 2006). The Court may request an advisory verdict from the jury but the Court
16 must make the ultimate decision regarding inequitable conduct. AIPLA Jury
17 Instructions, at 49.

18 Applicants for a patent have a duty to prosecute patent applications in the Patent
19 and Trademark Office with candor and good faith. This duty of candor and good
20 faith extends to all inventors named on a patent application, all patent attorneys and
21 patent agents involved in preparing and prosecuting the application, and every other
22 individual involved in a substantial way with the prosecution of the patent
23 application. An intentional failure to meet this duty of candor and good faith is
24 referred to as “inequitable conduct.” AIPLA Jury Instructions, at 50; *see also*
25 *Therasense, Inc. v. Becton Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011) (*en
banc*).

27 To determine whether Spigen 283 was obtained through inequitable conduct, the
28 Court must determine:

- 1 1. Whether an individual or individuals having this duty of candor and good
2 faith [engaged in affirmative acts of egregious misconduct or] withheld or
3 misrepresented information, or submitted false information, that was material to the
4 examination of the patent application; and
5 2. Whether the individual or individuals acted with the specific intent to deceive
6 or mislead the Patent and Trademark Office. AIPLA Jury Instructions, at 50; *see*
7 also *Therasense, Inc. v. Becton Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011)
8 (*en banc*).

D. LIMITATIONS ON DAMAGES-FAILURE OF PATENT MARKING

Defendants have two affirmative defenses that relate to the failure of patent marking (Fourth and Fifth Affirmative Defenses). There is no counterclaim related to that issue.

The date that Plaintiff first notified Defendants of its claim for patent infringement is the date for the start of damages. When the parties do not agree on that date, it is up to you to the jury to determine what that date is. Plaintiff must prove that it is more likely than not that Defendants actually were notified of the claim for patent infringement as of the date alleged by Plaintiff. AIPLA Jury Instructions, at 53.

Plaintiff could have given the required notice in two ways. The first way is to give notice to the public in general. Plaintiff could have done this by marking substantially all of the products that it sold which included the patented invention, or including on the labeling of substantially all of the products, the word “patent” or the abbreviation “PAT” with the patent number of Spigen 283. AIPLA Jury Instructions, at 54.

Plaintiff could also have given the first type of public notice by marking substantially all of the products with “Patent” or “Pat” and a free internet address where there is a posting that connects the product with the patent number of Spigen 283. Any licensees of Spigen 283 who use the patented invention must also mark

1 substantially all of their products that include the patented invention with the patent
2 number. This type of notice starts from the date the Plaintiff and any licensees began
3 to mark substantially all of their products that used the patented invention with the
4 patent number. If Plaintiff and any licensees did not mark substantially all of those
5 products with the patent number, then Plaintiff did not provide notice in this way.
6 AIPLA Jury Instructions, at 54.

7 A second way Plaintiff could have given notice of its patent is to notify
8 Defendants directly with a specific claim that the accused products infringed Spigen
9 283. This type of notice starts from the date Defendants received the notice. If you
10 find that Plaintiff, before filing this lawsuit, did not properly mark its products and
11 did not notify Defendant with a specific charge that the accused products, then
12 Plaintiff can only recover damages for infringement that occurred after it sued
13 Defendants on [lawsuit filing date]. AIPLA Jury Instructions, at 54.

14 **III. CONTENTIONS OF LAW**

15 **A. THE LAW OF NON-INFRINGEMENT**

16 1. Plaintiff Spigen bears the burden of proving infringement by a preponderance
17 of the evidence. *Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems,*
18 *Inc.*, 262 F.3d 1329, 1336 (Fed. Cir. 2001).

19 2. Determining whether Defendants' cell phone holders infringe Spigen 283
20 requires a two step analysis: First, disputed terms in the asserted patent claims
21 should be construed to determine their scope and meaning. *Freedman Seating Co.*
22 *v. Am. Seating Co.*, 420 F.3d 1350, 1356 (Fed. Cir. 2005).

23 3. Proper claim construction analysis begins by considering the language of the
24 claims themselves. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005)
25 (*en banc*). Claims should be given their ordinary and customary meaning consistent
26 with the specification and prosecution history, as that meaning would have been
27 understood by a person of ordinary skill in the art at the time of the invention. *Id.* at
28 1312-1313, 1315, 1317.

1 4. The second step of infringement analysis is to compare the properly construed
2 claims to Defendants' accused products so as to determine whether there is
3 infringement. *Terlep v. Brinkman Corp.*, 418 F.3d 1379, 1381 (Fed. Cir. 2005).

4 5. If a single element of an asserted claim is absent from Defendants' accused
5 products, both literally and under the doctrine of equivalents, there is no
6 infringement. *Id.* at 1385.

7 6. There is literal infringement only if every word of the claim at issue reads on
8 the accused product(s). *Microsoft Corp. v. Geo Tag, Inc.*, _ F.3d _, 2016 WL
9 1274394 at *6 (Fed. Cir. 2016); *Revolution Eyewear, MC v. Aspex Eyewear, Inc.*,
10 563 F.3d. 1358, 1369 (Fed. Cir. 2009).

11 7. Alternatively, if an element or elements of the claim are not literally found in
12 the accused product, there can be infringement under the doctrine of equivalents if
13 the differences between the claimed invention and the accused product are
14 "insubstantial." *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1359 (Fed.
15 Cir. 2000).

16 8. The differences are "insubstantial" if each element of the accused product
17 performs substantially the same function in substantially the same way to achieve
18 substantially the same result, as the claimed invention. *Graver Tank & Mfg. Co. v.*
19 *Linde Air Products Co.*, 339 U.S. 605, 608 (1950); *see also Ring & Pinion Service*
20 *Inc. v. ARB Corp.*, 743 F.3d 831, 835 (Fed. Cir. 2014).

21 9. On the other hand, if one or more of the three function-way-result elements is
22 missing from the accused product(s) for any claim element, there is no doctrine of
23 equivalents infringement and thus no patent infringement. *See AKZO Nobel*
24 *Coatings, Inc. v. DOW Chemical Co.*, 811 F.3d 1334, 1342 (Fed. Cir. 2016).

25 10. If an independent claim is not infringed, then all claims that depend from
26 that independent claim are not infringed. *See Wahpeton Canvas Co. v. Frontier,*
27 *Inc.*, 870 F.2d 1546, 1552 n.9 (Fed. Cir. 1989).

28

1 11. By statute, “means-plus-function” language in a patent claim term “shall be
 2 construed to cover the corresponding structure, material, or acts described in the
 3 specification and equivalents thereof.” 35 U.S.C. § 112(f) (emphasis added); *see*
 4 *also MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1169 (Fed. Cir. 2015).

5 12. When the specification of a patent, including the claims, does not define
 6 particular claim language explicitly or impliedly, extrinsic evidence regarding the
 7 meaning of that claim language may be considered; dictionary definitions of a claim
 8 term are appropriately used by the courts for that purpose. *Trivascular, Inc. v.*
 9 *Samuels*, 812 F.3d 1056, 1062-63 (Fed. Cir. 2016); *Trustees of Columbia University*
 10 *v. Symantec Corp.*, 811 F.3d 1359, 1362-63 (Fed. Cir. 2016).

11 13. Clear and convincing evidence is required to establish willful infringement.
 12 *Bard Peripheral Vascular, Inc. v. W.L. Gore & Associates, Inc.*, 682 F.3d 1003,
 13 1006-08 (Fed. Cir. 2012).

14 14. Whether the defendant presented a substantial defense to infringement,
 15 including the defense of invalidity or unenforceability, can negate willful
 16 infringement. *Id.*

17 **B. LAW OF INVALIDITY UNDER 35 U.S.C. 103 (OBFVIOUSNESS)**

18 14. Defendants bear the burden of proving invalidity by clear and convincing
 19 evidence. *Dome Patent L.P. v. Lee*, 799 F.3d 1372, 1378 (Fed. Cir. 2015).

20 15. 35 U.S.C. § 103 states as follows:

21 “**A patent for a claimed invention may not be obtained, notwithstanding that**
 22 **the claimed invention is not identically disclosed as set forth in section 102, if**
 23 **the differences between the claimed invention and the prior art are such**
 24 **that the claimed invention as a whole would have been **obvious** before the**
 25 **effective filing date of the claimed invention to a person having ordinary skill**
 26 **in the art to which the claimed invention pertains. Patentability shall not be**
 27 **negated by the manner in which the invention was made.”** [emphasis added]

1 16. In 2007, the U.S. Supreme Court issued a decision regarding invalidity under
 2 35 U.S.C. § 103 that changed the way that obviousness under 35 U.S.C. § 103 is
 3 analyzed. In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727 (2007),
 4 the U.S. Supreme Court reversed a determination of non-obviousness (under 35
 5 U.S.C. § 103) by the Court of Appeals for the Federal Circuit.

6 17. In *KSR*, the Supreme Court reversed the Federal Circuit's then-established
 7 obviousness analysis that used a "rigid approach" of the requirement of a "teaching,
 8 suggestion or motivation" in the prior art for combining pre-existing elements. *Id.*
 9 at 415.

10 18. The *KSR* Court emphasized "the need for caution in granting a patent based
 11 on the combination of elements found in the prior art," citing the Supreme Court's
 12 prior admonition "that a 'patent for a combination which only unites old elements
 13 with no change in their respective functions ... obviously withdraws what is already
 14 known into the field of its monopoly and diminishes the resources available to
 15 skillful men." *Id.* at 416 (citing *Great Atlantic & Pacific Tea Co. v. Supermarket*
 16 *Equipment Corp.*, 340 U.S. 147, 152 (1950)) (emphasis added).

17 19. The *KSR* Court determined that the foregoing admonition is the "principle
 18 reason" that "[the] combination of familiar elements according to known methods is
 19 likely to be obvious when it does no more than yield predictable results." *Id.* at 416
 20 (emphasis added).

21 20. In concluding its discussion of the legal principles of obviousness, the
 22 Supreme Court in *KSR* stated that:

23 "When there is a design need ... to solve a problem and there are a finite
 24 number of identified, predictable solutions, a person of ordinary skill has
 25 good reason to pursue the known options within his or her technical grasp. If
 26 this leads to the anticipated success, it is likely the product not of innovation
 27 but of ordinary skill and common sense."

28 *Id.* at 421 (emphasis added).

1 21. Since the *KSR* decision, the Federal Circuit has repeatedly found obvious
2 combinations of prior art elements that provided the same function in the claimed
3 invention as they did in the prior art. For example, in *In re Icon Health and Fitness,*
4 *Inc.*, 496 F.3d 1374 (Fed. Cir. 2007), the invention was a folding treadmill that used
5 a gas spring to hold it in its folded position. One prior art patent disclosed a folding
6 treadmill and another prior art patent disclosed a gas spring for a folding bed that
7 held the bed in its folded position. After citing *KSR*, the Federal Circuit held the
8 claimed invention was obvious under 35 U.S.C. § 103 while stating that “[o]ne
9 skilled in the art would naturally look to prior art addressing the same problem at
10 hand, and in this case would find an appropriate solution.” *Id.* at 1380.

11 22. In *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157 (Fed. Cir.
12 2007), the invention was an auditory learning device for helping young children to
13 read phonetically. A prior art patent disclosed an “electro-mechanical” auditory
14 learning toy providing the same operational functions but without the modern
15 electronic elements used in the invention. *Id.* at 1161. Another prior art learning
16 toy product with “a slightly different mode of operation” used all but one of the
17 claimed electronic elements, a “reader.” *Id.* at 1161-62. The “reader” element,
18 however, was found to be “well-known in the art at the time of the invention.” *Id.* at
19 1162. The Federal Circuit affirmed the district court’s finding of obviousness, citing
20 *KSR*’s principle of the likely obviousness of “familiar elements” that “yield
21 predictable results.” *Id.* at 1161 and 1163.

22 23. *Randall Mfg. v. Rea*, 733 F.3d 1355 (Fed. Cir. 2013) related to an invention
23 for moveable bulkheads for partitioning cargo space designed to be lifted and
24 stowed near the ceilings of shipping containers. The Federal Circuit vacated the
25 U.S. Patent Office’s Patent Trial and Appeal Board’s determination that the
26 invention was non-obvious in view of four prior art references. The Court
27 overturned the decision below because the Board did not consider extensive
28 background prior art references (beyond the four cited references) showing that a

1 “prevalent … method of stowing a bulkhead panel was to raise it to the ceiling.” *Id.*
 2 at 1363. The Court admonished the Board for ignoring evidence that the design of
 3 the claimed invention was “nothing more than the ‘combination of familiar elements
 4 according to known methods’ … [and] ‘performing the same function it had been
 5 known to perform,’ ” citing and quoting *KSR*. *Id* (internal quotations omitted).

6 24. *Acco Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361 (Fed. Cir. 2016)
 7 involved an invention for a paper shredder that had a controller, thickness detector
 8 and presence detector combination. The claimed shredder required detection and
 9 recordation of the appropriate thickness of the paper and the presence of the paper in
 10 the paper feeder, in that order, before the controller turned on the shredder when the
 11 appropriate parameters were present. *Id*, at 1367. All three elements and their
 12 functions were present in the prior art but no prior art device had determined an
 13 appropriate thickness of the paper before the presence sensor was allowed to
 14 activate the shredder. *Id*, at 1366-67. The Federal Circuit reversed the U.S. Patent
 15 Trial and Appeal Board’s determination that the patent examiner had inappropriately
 16 found a *prima facie* case of obviousness of the claimed invention under 35 U.S.C. §
 17 103, citing *KSR*. *Id*, at 1367-68.

18 25. In order for “secondary considerations” such as “commercial success,”
 19 “unexpected results,” “praise and industry acclamations” and “copying by others” to
 20 be “significant” evidence of non-obviousness, there must be a “nexus between the
 21 claimed invention” and the secondary consideration, such as commercial success.
 22 *Ormco Corp. v. Align Technology, Inc.*, 463 F.3d 1299, 1311-12 (Fed. Cir. 2006).

23 26. Also, if a “feature” of the invention is in the prior art and Plaintiff claims
 24 that feature results in a “secondary consideration” such as commercial success, the
 25 secondary consideration is not relevant to obviousness analysis. *Id*.

26 **C. LAW OF INDEFINITENESS UNDER 35 U.S.C. 112(b)**

27 27. 35 U.S.C. 112(b) provides: “The specification shall conclude with one or
 28 more claims particularly pointing out and distinctly claiming the subject matter

1 which the inventor or a joint inventor regards as the invention.” A violation of this
 2 statutory requirement is described as “indefiniteness.”

3 28. As stated in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120
 4 (2014), “a patent is invalid for indefiniteness if its claims, read in light of the
 5 specification delineating the patent, and the prosecution history, fail to inform, with
 6 reasonable certainty, those skilled in the art about the scope of the invention.”

7 **D. LAW OF INEQUITABLE CONDUCT**

8 27. Inequitable conduct supports an award of attorneys’ fees when the patent
 9 was obtained from the United States Patent and Trademark Office (“USPTO”) in
 10 violation of the duty of candor and disclosure imposed on every patentee. *See*
 11 *Taltech Limited v. Esquel Enterprises Limited*, 604 F.3d 1324, 1328 (Fed. Cir.
 12 2010); *see also* 37 C.F.R. § 1.56.

13 28. “Unlike validity defenses, which are claim specific, … inequitable conduct
 14 regarding **a single claim** renders the entire patent unenforceable.” *Therasense, Inc.*
 15 *v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1288 (Fed. Cir. 2011) (*en banc*)
 16 (emphasis added).

17 29. “To establish inequitable conduct, the accused infringer must prove by clear
 18 and convincing evidence that the patentee withheld **material** information with
 19 **intent to deceive** the PTO.” *Taltech*, 604 F.3d at 1328 (emphasis added). In short,
 20 the elements of inequitable conduct are materiality and intent to deceive.

21 30. “[T]he materiality required to establish inequitable conduct is but-for-
 22 materiality. When an applicant fails to disclose prior art to the PTO, that prior art
 23 has but-for-materiality if the PTO would not have allowed a claim had it been aware
 24 of the undisclosed prior art.” *Therasense*, 649 F.3d at 1291 (Fed. Cir. 2011).

25 31. The **materiality** prong is to be determined on a **preponderance of evidence**
 26 standard because that is the standard used in the USPTO to determine whether a
 27 patent claim should be rejected. *Therasense*, 649 F.3d at 1291-92 (“In assessing the
 28 materiality of a withheld reference, the court must determine whether the PTO

would have allowed the claim if it had been aware of the undisclosed reference. In making that determination, the court should apply the preponderance of the evidence standard") (emphasis added); *Aventis Pharma S.A. v. Hospira, Inc.*, 675 F.3d 1324, 1334 (Fed. Cir. 2012) ("[T]he standard for establishing but-for materiality in the inequitable conduct context only requires a preponderance of the evidence") (citing *Therasense*).

32. The intent to deceive prong, on the other hand, must be satisfied by clear and convincing evidence. *Therasense*, 649 F.3d at 1290 (emphasis added).

33. "Because direct evidence of deceptive intent is rare, a district court may infer intent to deceive from indirect and circumstantial evidence." *Id.* at 1291.

34. "To meet the clear and convincing evidence standard, intent to deceive must be 'the single most reasonable inference able to be drawn from the evidence.'" *Therasense*, 649 F.3d at 1291.

E. LAW OF LIMITATIONS ON DAMAGES

35. In order to obtain damages in a patent case, the defendant must be notified of the claim of patent infringement. 35 U.S.C. 287(a); *Funai Electric Co. v. Daewoo Electronics Corp.*, 616 F.3d 1357, 1373-74.

36. Such notice can be given to the public generally by marking substantially all of the products Plaintiff sold, and that included the patented invention, with (i) the word "patent," or the abbreviation "PAT," along with the number of the patent or (ii) the word "patent" or "PAT" along with a free internet address having a posting that connects the product with the patent number. 35 U.S.C. 287(a).

37. Alternatively, Plaintiff can give the required notice directly to the defendant that the defendant's products allegedly infringe the patent in suit. *Funai*, at 1373; *see also* 35 U.S.C. 287(a).

IV. CONTENTIONS OF FACT

A. SUMMARY OF FACTS RE NON-INFRINGEMENT

1 1. Spigen 283 requires in claims 1 through 15 that an infringing device has “a
2 hard protective frame ... wherein the hard protective frame comprises **grooves**”
3 (“grooves limitation”). Spigen 283 at col. 6, lines 65-67 (emphasis added).

4 2. The Court has construed the term “groove” in the grooves limitation of claim
5 1 and its dependent claims to mean “any long and narrow channel, hollow, cut, or
6 indentation in a surface.” Court’s July 22, 2016 Order at page 10, line 19.

7 3. In claims 16 through 22, Spigen 283 requires that an infringing device has “a
8 sliding means for sliding a cover forward and backward with respect to the hard
9 protective frame” (“sliding means limitation”). Spigen 283 at col. 8, lines 26-27.

10 4. The Court has construed the term “sliding means” in claim 16 to mean “rails
11 in a cover that slide along **grooves** formed in the hard protective frame of a case.”
12 Court’s July 22, 2016 Order at page 11, lines 1-2 (emphasis added).

13 5. Defendants’ accused products in this case do not have “grooves” literally or
14 under the doctrine of equivalents, and therefore do not infringe any claims of Spigen
15 283.

16 6. Defendants’ accused products in this case do not have “rails in a cover” that
17 “mate with” or are “slidably mounted on” the “grooves” in the “hard protective
18 frame,” either literally or under the doctrine of equivalents. Therefore, the accused
19 products do not infringe claims 1 through 15 and 17 of Spigen 283 for that separate
20 reason.

21 7. Regarding claims 5 and 20, the claimed “protuberance on an opposite side of
22 the indentation structure of the hard protective frame” is not present in the accused
23 devices and so there is no literal or doctrine of equivalents infringement for an
24 additional reason. There is also no infringement of the same claims because
25 Plaintiff is contending that the same structures are the “grooves” in claim 1 (upon
26 which claims 5 and 20 depend) and also the “protuberance” in claims 5 and 20. The
27 “grooves” and the “protuberance” are different claim elements.
28

1 8. Claim 7 is not infringed because the claim requires that “the side walls of the
 2 cover are slanted.” The accused devices have only one slanted side wall on the
 3 cover, not two, as claimed. Therefore, claim 7 is also not infringed for that reason.

4 9. Claim 12 requires a “cavity” in the “hard protective frame.” There is no such
 5 “cavity” or its equivalent in the accused devices and so there is no literal or doctrine
 6 of equivalents infringement of claim 12 for that additional reason.

7 10. Regarding claim 14, again, Plaintiff is attempting to assert that the alleged
 8 “groove” structure (i.e., the step structure in the accused devices) also satisfies a
 9 different limitation set forth in claim 14, namely the “long protrusion.” That is
 10 improper because the “long protrusion” of claim 14 is a separate element of the
 11 claimed device.

12 11. Concerning claims 15 and 22, the elements in the accused devices asserted
 13 to be a “long protrusion” and a “long recess” are completely different from the
 14 claimed and disclosed elements. There is no literal or doctrine of equivalents
 15 infringement.

16 **B. SUMMARY OF FACTS RE OBVIOUSNESS**

17 12. The prior art items that Defendants are asserting in this case regarding
 18 obviousness are as follows:

- 19 (a) Korean Registered Utility Model 20-0472435 (“KUM435”);
- 20 (b) Plaintiff Spigen’s “Slim Armor” prior art cell phone carrier (“Spigen-1”);
- 21 (c) U.S. Patent Publication No. 2012/0067751 to Mongan et al. (“Mongan”);
- 22 (d) Third party Incipio’s “Stowaway Credit Card Case” product (“Incipio”).
- 23 (e) U.S. Patent No. 8,245,842 to Bau (“Bau”);
- 24 (f) Third party OtterBox’s “Commuter Series Wallet” product (“OtterBox”);
- 25 (g) DAMDA Cotton case for Galaxy S5 (“DAMDA”); and
- 26 (h) DESIGNSKIN for iPhone 5/5S (“DESIGNSKIN-1”).

27

28

1 13. The only independent claims of Spigen 283, namely claims 1 and 16, are
2 obvious under KUM435 alone. The only elements KUM435 does not disclose from
3 claim 1 are “a raised wall formed on a bottom surface of the back panel to form the
4 storage compartment,” and only the “removably” element in the claim 1 language,
5 “a hard protective frame configured to removably mount over the soft protective
6 case.” The “raised wall” from the back panel of the soft protective case (instead of
7 from the “hard protective frame,” as in KUM435) is a matter of obvious design
8 choice, as is the “removab[ility]” of the hard protective frame from the soft
9 protective case, from the perspective of a person of ordinary skill in the art.
10 KUM435 in fact discloses two embodiments, one in which the hard protective frame
11 provides the bottom of the card storage compartment and a second in which the soft
12 protective case provides the bottom of the card storage compartment. It would be
13 obvious to a person of ordinary skill in the art to bring the necessary wall up from
14 the bottom of the soft protective case using the same material as that found in the
15 soft protective case, in the second embodiment disclosed in KUM435.

16 14. The elements discussed in all of the combinations of prior art discussed
17 below perform the same function in the combination as they do individually. In
18 addition, the combination fits together and performs functionally as expected by a
19 person of ordinary skill in the art, rendering the claims obvious.

20 15. Claims 1 and 16 are also obvious in view of KUM435 in view of Spigen-1.
21 Spigen-1 provides the “removab[ility]” feature missing from KUM435, that is a
22 hard protective frame that is removably mounted on a soft protective case. The
23 result would be the cell phone case of claim 16. The only other element of claim 1
24 not found in KUM435 (namely, the “raised wall” element) would be a matter of
25 obvious design choice.

26 16. Claims 1 and 16 are further obvious in view of KUM435 in view of Spigen-
27 1 and Incipio. As explained above, KIM435 and Spigen explicitly disclose all of the
28 elements of claim 16 and all elements of claim 1 but the “raised wall” limitation.

1 Incipio discloses “a raised wall formed on a bottom surface of the back panel to
2 form the storage compartment.”

3 17. Claims 1 and 16 are obvious in view of KUM435 in view of Incipio. Incipio
4 discloses both the “removab[ility]” limitation and the “raised wall” limitation (i.e.,
5 from a soft protective case holding a cell phone with a hard protective removably
6 mounted on the soft case).

7 18. Claims 1 and 16 are obvious in view of KUM435 and further in view of
8 OtterBox and Mongan. OtterBox discloses, among others disclosed by KUM435,
9 the “removab[ility]” feature. Mongan discloses the “raised wall” from the floor of a
10 card storage compartment both made of soft material.

11 19. Claims 1 and 16 are obvious in view of KUM435 and further in view of Bau
12 and Mongan. Bau discloses, among others disclosed by KUM435, the
13 “removab[ility]” feature. Mongan discloses the “raised wall” from the floor of a
14 card storage compartment both made of soft material.

15 20. Claims 1 and 16 are further obvious in view of KUM435 in view of Spigen-
16 1 and Incipio. As explained above, KIM435 and Spigen explicitly disclose all of the
17 elements of claim 16 and all elements of claim 1 but the “raised wall” limitation.
18 Mongan discloses “a raised wall formed on a bottom surface of the back panel to
19 form the storage compartment.”

20 21. Claims 1 and 16 are further obvious in view of KUM435 in view of Damda.
21 Damda discloses the “removab[ility]” feature as well as a “raised wall” from a card
22 storage compartment for which the floor and the wall are made of soft material.

23 22. Claims 1 and 16 are further obvious in view of Incipio in view of OtterBox.
24 Incipio discloses all elements of claims 1 and 16, including a cover for a card
25 storage compartment, without the sliding feature for the cover. Incipio also lacks
26 grooves in the hard protective frame and rails in the cover that slide on the grooves.
27 OtterBox discloses a cover for card storage that slides as well as the grooves and
28 rails limitations.

1 23. Claims 1 and 16 are obvious in view of KUM435 in view of Mongan.
2 Mongan discloses both the “raised wall” limitation (i.e., from a soft protective case
3 holding a cell phone with a hard protective removably mounted on the soft case).

4 24. Claims 1 and 16 are further obvious in view of Incipio in view of
5 Designskin-1. Incipio discloses all elements of claims 1 and 16, including a cover
6 for a card storage compartment, without the sliding feature for the cover. Incipio
7 also lacks grooves in the hard protective frame and rails in the cover that slide on the
8 grooves. Designskin-1 discloses a cover for card storage that slides as well as the
9 grooves and rails limitations.

10 25. As for the limitations in the remaining claims, Incipio has all of the
11 additional elements of dependent claims 1 through 5, 8, 14 through 16, 18 through
12 20 and 22. For those combinations above not including Incipio, combining those
13 prior art references further in view of Incipio would render obvious to a person of
14 skill in the art the new combination, under the same reasoning used above.
15 Otherwise, the combination for obviousness remains the same.

16 26. Regarding dependent claims 1, 6, 11, 16 and 17, OtterBox has all of the
17 additional elements of those claims and, for those combinations above not including
18 OtterBox, combining those prior art references further in view of OtterBox would
19 render obvious to a person of skill in the art the new combination, under the same
20 reasoning used above.

21 27. Regarding dependent claims 3 and 19, Spigen-1 has all of the additional
22 elements of those claims and, for those combinations above not including Spigen-1,
23 combining those prior art references further in view of Spigen-1 would render
24 obvious to a person of skill in the art the new combination, under the same
25 reasoning used above.

26 28. Regarding dependent claim 10, Damda has all of the additional elements of
27 that claim and, for those combinations above not including Damda, combining those
28

1 prior art references further in view of Damda would render obvious to a person of
2 skill in the art the new combination, under the same reasoning used above.

3 29. Regarding dependent claims 12 and 13, Designskin-1 has all of the
4 additional elements of those claims and, for those combinations above not including
5 Designskin-1, combining those prior art references further in view of Designskin-1
6 would render obvious to a person of skill in the art the new combination, under the
7 same reasoning used above.

8 **C. SUMMARY OF FACTS RE INDEFINITENESS**

9 30. In Spigen 283, the elements claimed to be the “long recess” and the “long
10 protrusion” in claims 15 and 22 are the bottom portions of the extreme left and right
11 sides of the “hard protective frame” and “the soft protective case.”

12 31. Those elements match up without any attachment features in them. They are
13 described as the “[l]ower side of the indentations 26” (i.e., the “long recess”) and
14 “the complementary structures 36” (i.e., the “long protrusion”) at col. 4, lines 16-21
15 of Spigen 283. These are merely narrow, long overlapping elements with no
16 attachment features (i.e., the hard frame “long recess” at “26” in FIG. 4 overlaps the
17 soft case “long protrusion” at “36” in FIG. 5A).

18 32. Plaintiff asserts that elements in the accused products that involve the
19 insertion of ridges in a hard frame into slots in a soft case infringe to securely attach
20 the hard frame to the soft case are extremely different features of their products than
21 those claimed and described as the “long recess” and the “long protrusion” in
22 Spigen 283.

23 33. Defendants assert that Plaintiff’s position here is a classic example of using
24 such overbroad claim language that the public would never anticipate that there was
25 infringement if it evaluated Spigen 283 carefully.

26 **D. SUMMARY OF FACTS RE INEQUITABLE CONDUCT**

27 34. As explained above, KUM435 discloses almost all of the elements of both
28 claim 1 and claim 16 of Spigen 283 and renders both of those claims obvious,

1 although only one of those claims need be invalid, in view of KUM435, to satisfy
 2 the but-for materiality standard for inequitable conduct. The same is true regarding
 3 an obvious combination of KUM '435 with Mongan alone, because Mongan was
 4 cited by the examiner during the prosecution of Spigen 283.

5 35. Spigen was accused in a cease and desist letter of infringing KUM '435 by a
 6 third party in Korea before Spigen 283 was being prosecuted in the USPTO.
 7 Therefore, not only did Spigen have knowledge of KUM '435, Plaintiff was fully
 8 and acutely aware that the KUM '435 reference was likely highly relevant to the
 9 subsequently-filed Spigen 283 patent application.

10 36. However, Spigen did not disclose KUM435 to the U.S. Patent and
 11 Trademark Office during the prosecution of the Spigen 283 application.

12 37. Nor did Spigen or its attorney, who prosecuted Spigen 283 and is counsel of
 13 record in this action, seek reissue or reexamination of Spigen 283 in the USPTO,
 14 even after warning letters from Defendants' counsel about the high degree of
 15 relevance of KUM435 to Spigen 283 before this lawsuit was filed. Instead, Spigen
 16 and its counsel brought this lawsuit.

E. SUMMARY OF FACTS RE LIMITATIONS ON DAMAGES

18 38. Plaintiff failed to properly mark its patented products after Spigen 283
 19 issued under either of 35 U.S.C. 287's methods for doing so.

20 40. Plaintiff did not do so until after Plaintiff sent Defendants a cease and desist
 21 letter accusing Defendants of infringement not long before this case was filed.

22 41. Any damages awarded to Plaintiff this action should be reduced accordingly.

V. BIFURCATION OF ISSUES AND JURY TRIAL

24 Although inequitable conduct is an issue for the Court to decide, *Flex-Rest, LLC*
 25 v. *Steelcase, Inc.*, 455 F.3d 1351, 1357 (Fed. Cir. 2006), the Court may submit the
 26 issue to the jury for an advisory verdict. AIPLA Model Jury Instructions, at 49.
 27 Defendants believe and advisory verdict would be appropriate in this case because
 28

1 the issue is properly raised and there is sufficient evidence to support the defense.

2 *Id.*

3 Defendants believe a jury trial demand has been made, which would apply to the
4 issues of infringement, invalidity and damages.

5 **VI. ATTORNEYS' FEES**

6 Defendants' anticipate that they may be seeking attorneys' fees under 35 U.S.C §
7 285, 28 U.S.C. § 1927, this Court's inherent power. *See, e.g., Octane Fitness LLC*
8 *v. Icon Health Fitness Inc.*, 134 S. Ct. 1749, 1758 (2014) (lowering the standard for
9 awarding attorneys' fees to defendants in patent infringement cases under 35 U.S.C.
10 § 285) (also stating that “[w]e have long recognized a common-law exception to the
11 general American rule against fee-shifting—an exception, inherent in the power [of]
12 the courts that applies for willful disobedience of a court order or when the losing
13 party has acted in bad faith, vexatiously, wantonly, or for oppressive reasons”)
14 (citations and quotations omitted).

15 **VII. ABANDONMENT OF ISSUES**

16 Defendants have abandoned its Affirmative Defenses Nos. I, VI and VII.

17 Defendants have not abandoned any other pleaded claims or defenses.

18 **VIII. CONCLUSION**

19 For the foregoing reasons, Defendants request that the Court determine that
20 Spigen 283 is not infringed and is invalid under 35 U.S.C. § 103 in its entirety.

21 PARK LAW FIRM

22 Dated: July 25, 2016

24 By: /s/ Mark L. Sutton

25 John K. Park

26 Mark L. Sutton

27 Attorneys for Defendant/Counterclaimant

28 VERUS U.S.A. LLC

PROOF OF SERVICE

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and am not a party to the within action. My business address is 3255 Wilshire Blvd., Suite 1110, Los Angeles, California 90010.

On July 25, 2016, I caused the foregoing document(s) described as DEFENDANTS ISPEAK[ER] AND VERUS' MEMORANDUM OF CONTENTIONS OF FACTS AND LAW to be served on the parties in this action, as follows:

Mr. Heedong Chae, Esq.
EastWest Law Group
00 Wilshire Blvd., Suite 7
Los Angeles, CA 90010
hdchae@ewpat.com

() (BY PERSONAL DELIVERY) I am readily familiar with the business practice of my place of employment in respect to personal service. The foregoing sealed envelope was personally delivered to the above address.

(X) (BY U.S. MAIL) I am readily familiar with the business practice of my place of employment in respect to the collection and processing of correspondences, pleadings and notices for mailing with United States Postal Service. The foregoing sealed envelope was placed for collection and mailing this date consistent with the ordinary business practice of my place of employment, so that it will be picked up this date with postage thereon fully paid at Los Angeles, CA, in the ordinary course of business.

() (BY EMAIL) I served a true and correct copy by email to the email address shown above per prior agreement between the parties.

(X) (BY EM/ECF) It is believed that EM/ECF will automatically generate the court filed version of this document immediately at the time of filing and serve the above named parties.

(X) (FEDERAL) I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Date: July 25, 2016

By: /s/John K. Park
John K Park